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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/912,079 | 07/24/2001 | Todd R. Collart | IA 1510.01 US | 3412 |

22887 7590 02/26/2004

DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
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IRVINE, CA 92614

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| EXAMINER |
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MCCLELLAN, JAMES S

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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,079

Applicant(s)

COLLART, TODD R.

Examiner

James S McClellan

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MC

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/4/01, 1/7/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on January 7, 2004, wherein:

claims 1-14 are pending and

claims 1-14 have been amended.

Information Disclosure Statement

2. As requested by Applicant, the Examiner has reviewed two reference that were not initialed on the PTO-1449 mailed with the first office action. Additionally, the Examiner has included a signed copy of the PTO-1449 submitted on 1/7/04.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,035,329 (Mages et al.).

Regarding **claim 1**, Mages et al. discloses a method for tracking usage of a recording medium comprising: receiving a first indicia (see column 2, lines 46-51) corresponding to an

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identifier of the recording medium upon the recording medium being input into a device by a user; receiving a second indicia identifying the device (see column 4 lines 4-19); determining a characteristic of the recording medium based on the first indicia (see column 3, lines 27-31); identifying the client device based upon the second indicia (it is inherent that the client device has an identification number because the client device is in communication with a service provider over the Internet); and storing the characteristic of the recording medium and the identity of the device in a database (see column 3, lines 45-55); **[claim 2]** the characteristic of the recording medium includes an intended usage (see column 3, lines 27-31, requiring or not requiring pay-per-view); **[claim 3]** the characteristic of the recording medium includes whether the recording medium was intended for rental (pay-per-view) or retail sale (not pay-per-view); **[claim 4]** utilizing the client device to read the identifier (see column 4, lines 4-19); and transmitting indicia corresponding to the identifier from the client device to a server via the Internet utilizing a browser embodied on the client device (see column 3, lines 45-55); **[claim 5]** determining a manner in which the recording medium is being used by the client device based on the determined client identity and recording medium characteristic (see column 3, lines 27-31; requiring or not requiring pay-per-view); and **[claim 14]** the determined characteristic of the recording medium is that the recording medium has been stolen, the method further comprising the step of disallowing play of the recording medium based upon the determination that the recording medium has been stolen (see column 4, lines 33-41).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 4,658,093 (Hellman).

Regarding **claims 6, 12, and 13**, Mages et al. fails to explicitly disclose the step of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only on an identified client device; and monitoring the number of times the recording medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times.

Hellman teaches the steps of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only on an identified client device (see Abstract, lines 11-14, "base unit specific"); and monitoring the number of times the recording medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times (see column 4, lines 21-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with the recording medium monitoring features taught by Hellman, because monitoring the use of a recording medium helps reduce software piracy (see Hellman, Abstract).

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7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 6,332,126 (Peirce et al.).

Regarding **claims 7-9**, Mages et al. fails to explicitly disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information.

Peirce et al. teaches the use of disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information (see column 2, lines 15-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with merchant monitoring of Peirce et al., because monitoring merchant information increases the data associated with the user's purchasing history and will improve marketing for potential merchants.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 6,260,758 (Blumberg).

Regarding **claims 10 and 11**, Mages et al. fails to explicitly disclose affinity programs that include issuing random prizes and offering coupons.

Blumberg teaches the use of affinity programs that include issuing random prizes and offering coupons (see paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with the affinity programs taught by Blumberg, because affinity programs increase the customers loyalty to the merchant.

Response to Arguments

9. Applicant's arguments filed January 7, 2004 have been fully considered but they are not persuasive.

On page 6, third and fourth paragraphs, Applicant requests consideration of two references from the IDS submitted 12/4/01 and the references submitted 1/7/04. As set forth above, the Examiner has considered all submitted references as indicated by the signed copies of PTO-1449 forms.

On page 6, final paragraph, Applicant notes that claim 3 was amended to overcome a claim objection. The objection of claim 3 is withdrawn.

On page 7, first paragraph, Applicant notes that claims 13 and 14 were amended to overcome rejections under 35 U.S.C. § 112. The 35 U.S.C. § 112 rejection of claims 13 and 14 are withdrawn.

On page 7, third paragraph, Applicant quotes three citations from Mages and states that Mages does not disclose the determining of a characteristic and two indices where the first indicia corresponds to an identifier of the recording medium and the second indicia identifies a device. The Examiner respectfully disagrees. Mages discloses the determining of a characteristic in column 2, lines 42-54 (see also column 3, lines 27-31), wherein the characteristic determined is whether a DVD is a pay-per-view DVD or a non-pay-per-view DVD. Additionally, Mages discloses a first indicia that corresponds to an identifier ("code 4", see column 3, lines 43-50, wherein a code embedded in header is verified with the service provider. Finally, Mages discloses a second indicia that corresponds to that identifies a device (see column 4, lines 30-34), wherein the software of the device communicates with the service

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provider. It is inherent that communication between the device (DVD-player) and the service provider must include an identifier of the device. Communication between the DVD-player and the service provider would be impossible if the service provider was unable how to identify the DVD-player.

On page 7, final paragraph, Applicant cites case law supporting that each and every element as set forth in a claim must be described in the reference. As set forth above, all claim elements are supported either directly or inherently by the Mages.

On pages 8-9, Applicant argues all 35 U.S.C. § 103 rejections based solely on the argument that the teaching references fail to disclose determining a characteristic of the recording medium based upon one of the two indices. As set forth above, Mages, not the secondary references, discloses determining a characteristic of the recording medium based upon one of the two indices.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

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statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

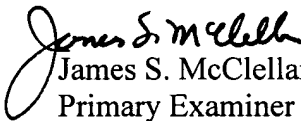
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
February 25, 2004